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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

48748US019

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on October 18, 2006

Signature

Typed or printed name James D. Withers

Application Number

10/655,331

Filed

September 4, 2003

First Named Inventor

Falaas

Art Unit

1711

Examiner

Tran, T.T.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 40,376

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature
James D. Withers

Typed or printed name

678-565-4748

Telephone number

October 18, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

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Patents

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
FALAAS) Art Unit: **1711**
)
Serial No.: **10/655,331**) Examiner: **Tran, T.**
)
Filing Date: **September 04, 2003**) 3M Matter No.: **48748US019**

For: **METALLIZED FILM AND DECORATIVE ARTICLES MADE**
THEREWITH

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal review of the present application for at least the following reasons:

1. International Patent Publication No. WO91/10562 to Ochi et al. (hereinafter, "Ochi") fails to anticipate previously presented claims 17-18, 21, 23-24, 35-37 and 39.

As discussed in Applicants' April 24, 2006 Amendment and Response and in Applicants' October 11, 2005 Amendment and Response, Ochi fails to disclose an article comprising a polyurethane substrate derived from an aqueous urethane dispersion, and therefore, cannot anticipate claims 17-18, 21, 23-24, 35-37 and 39.

2. Examiner Tran is not properly construing the claim features of previously presented claims 17-18, 21, 23-24, 35-37 and 39.

As discussed in Applicants' April 24, 2006 Amendment and Response and in Applicants' October 11, 2005 Amendment and Response, all claim features must be considered when determining whether a given reference anticipates a claim. Examiner Tran appears to ignore the claim feature "a polyurethane substrate derived from an aqueous urethane dispersion." Examiner Tran's justification for ignoring this claim feature is that Examiner Tran believes this language to product-by-process language.

Applicants submit that the language is not product-by-process language, and recites chemical construction of the recited polyurethane substrate. However, even if the language is considered to be product-by-process language, the language must be considered in an anticipatory analysis.

3. Examiner Tran is ignoring the evidentiary data of the previously submitted December 21, 2001 Declaration of Dr. Falaas.

Applicants previously submitted a December 21, 2001 Declaration of Dr. Falaas, which clearly demonstrates that polyurethane layers formed by aqueous dispersions are distinguishable from polyurethane layers formed from solution. The previously submitted Declaration of Dr. Falaas clearly states that polyurethane substrates derived from an aqueous urethane dispersion have a much higher elongation and tear strength properties when compared to polyurethane substrates derived from a solvent-based solution. See paragraphs (7), (8) and (10) of the Declaration.

4. Examiner Tran has failed to make a *prima facie* case of obviousness in view of the proposed combinations of any of the teaching of Ochi, the teaching of Dunning, and the teaching of Kunevicius.

As discussed in Applicants' April 24, 2006 Amendment and Response and in Applicants' October 11, 2005 Amendment and Response, the art of record fails to teach or suggest the desirability of modifying the articles of Ochi and/or Dunning as suggested by Examiner Tran. See, *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).